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Technology Center 2100

In re Application of: Califano, et al.
Application No. 09/457,732
Attorney Docket No. YO999-137
Filed: 12/10/1999
For: SEMIOTIC SYSTEM AND METHOD WITH PRIVACY PROTECTION

DECISION ON PETITION FOR SUPERVISORY REVIEW UNDER *37 CFR §1.181*

This is a decision on the petition under 37 CFR § 1.181, filed May 8, 2006, requesting the Commissioner to invoke his supervisory authority and issue a new Office action in lieu of the Final rejection mailed March 7, 2006.

The petition is **DISMISSED**.

RECENT PROSECUTION HISTORY

(1) On September 16, 2005, a non-final Office action, rejecting all pending claims (1 and 5-36), was mailed.

(2) On December 16, 2005, a response to the non-final Office action including remarks, was filed (note, claims 1 and 5-36 were ***not*** amended).

(3) On March 7, 2006, a final Office action, rejecting all pending claims (1 and 5-36), was mailed.

(4) On May 8, 2006, a response including remarks along with the instant petition, were filed.

RELIEF REQUESTED

The instant petition filed under 37 CFR 1.181 requests issuance of a new Office action.

ANALYSIS

The relevant sections of the M.P.E.P. are set forth below:

MPEP § 706.07(a) states in part that:
Under present practice, second or any subsequent action on the merits shall be made final, except where the examiner introduces a new ground of rejection not necessitated by amendment of the application by the applicant, whether or not the prior art is already of record. Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art ... of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

MPEP 1201, which sets forth:
The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a *>substantive< nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or **>other patentability issues<, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute >(35 U.S.C. 134)<.
The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the **>Director of the U.S. Patent and Trademark Office (Director)< should be carefully observed. The Board will not ordinarily hear a question **>that< should be decided by the *>Director on petition<, and the *>Director< will not ordinarily entertain a petition where the question presented is **>a matter appealable to the Board<. However, since 37 CFR 1.181(f) states that any petition not filed within 2 months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. In re Watkinson, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).

A review of the file record indicates that the final Office action mailed March 7, 2006 does not present a new ground(s) of rejection by the Examiner. Rather, the final Office action repeats all of the rejections set forth in the non-final Office action mailed September 16, 2005, with the exception of the earlier rejection under 35 USC 112 first paragraph, which has now been withdrawn. As clearly set forth in MPEP § 706.07(a) above, a second or subsequent Office action can be made final wherein the Examiner repeats the grounds of rejection from the previous Office action. Accordingly, the finality of the March 7, 2006 Office action is deemed to be proper.

Further, Applicant states in the instant petition that the (final) Office action presented by the Examiner, fails to advance the prosecution of the present application, since the Office action *does not properly take note of Applicant's arguments* or *answer the substance of those traversal positions* in compliance with M.P.E.P. § 707.07(f) and § 2144.08(III). The Examiner's position, as set forth in the final Office action, is that Applicant's arguments filed December 15, 2005 "have been fully considered but they are not persuasive" and that Applicant failed to provide "sufficient evidence to assert the invention's operability ..." for example (see final Office action, page 2 thereof).

As set forth in MPEP 1201 above, where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. 134). Such issues regarding differences of opinion are thus appealable, rather than petitionable.

Note, for informational purposes, Applicant and Examiner should be made aware, as set forth in MPEP § 707.07(f):

The importance of answering applicant's arguments is illustrated by In re Herrmann, 261 F.2d 598, 120 USPQ 182 (CCPA 1958) where the applicant urged that the subject matter claimed produced new and useful results. The court noted that since applicant's statement of advantages was not questioned by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable. See also In re Soni, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed. Cir. 1995) (Office failed to rebut applicant's argument).

CONCLUSION

Accordingly, for the above stated reasons, the petition and request to issue a new Office action in lieu of the final Office action of March 7, 2006 is **DISMISSED**.

Any inquiries related to this decision may be directed to Specials Program Examiner Brian Johnson at (571) 272-3595.

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